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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/115,764	07/15/1998	MICHAEL REASONER	65.748-449	1754

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EXAMINER

LUONG, VINH

ART UNIT PAPER NUMBER

3682

DATE MAILED: 08/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/115,764

Applicant(s)

REASONER, MICHAEL

Examiner

Vinh T Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-40 is/are pending in the application.
- 4a) Of the above claim(s) 30-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-29 and 37-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Vinh T. Luong
Primary Examiner

1. The Request for Reconsideration and Amendment after Appeal filed on April 17, 2002 has been entered. However, the examiner respectfully submits that applicant's claims are not in compliance with 37 CFR 1.173. New claims must be underlined in their entirety.

2. The interlineations or cancellations made in the specification or amendments to the claims could lead to confusion and mistake during the issue and printing processes. Accordingly, the portion of the specification or claims as identified below is required to be rewritten before passing the case to issue. See 37 CFR 1.125 and MPEP § 608.01(q).

All of the pending claims are required to be rewritten.

3. Claims 30-36 are withdrawn from consideration as being directed to a non-elected invention by original presentation. See paragraph 8 on page 3 of the Office action on December 21, 1999.

4. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant covers *all* amendments, including Amendments filed on November 26, 1999; April 17, 2002, and Examiner's Amendment, *etc.* Further, the stated error relied on was directed to claim 1 which has been canceled, therefore, applicant is required to submit a new statement of an error for one of the pending claims. See 37 CFR 1.175 and MPEP § 1414.

5. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 4-29 and 37-40 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

6. The patent sought to be reissued by this application has been involved in litigation. Any documents and/or materials which would be material to the patentability of this reissue application are required to be made of record in reply to this action.

Due to the related litigation status of this application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED DURING THE PROSECUTION OF THIS APPLICATION.

7. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,653,148 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation. Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application. These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, (a) the overall length of the first and second conduit sections, and the shortening of the overall length of the first and second conduit sections in claims 4, 17-20, 27 and 37; and (b) the *shortest* overall

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length of the conduit in claims 15 and 39; and (c) the locking member 19 that is abutted with the spring 22 in claim 27 must be shown or the features canceled from the claims. No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The examiner respectfully submits that Figs. 1, 3, and 4 merely show the portions of the first and second conduit sections 14 and 16, not their overall lengths. The shortening and the shortest overall lengths of the conduit sections are required to be shown in accordance with 37 CFR 1.84(h)(4). In addition, Figs. 3, 4, and 6 show that the locking member 19 is not abutted with the spring 22. As shown in the drawings, the spring 22 is abutted with the retainer 26. Applicant is respectfully urged to comply with 37 CFR 1.173(b)(3) regarding amended drawings.

9. Claims 4-29 and 37-40 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

It is well settled that a reissue application is not permitted to "recapture" claimed subject matter *deliberately* canceled in the original application. *In re Clement*, 45 USPQ 1161 (CAFC 1997). See MPEP 1412.02. Note also that in *Hester Industries, Inc. v. Stein, Inc.*, 46 USPQ2d 1641 (CAFC 1998), the Court held that the recapture rule can be triggered by argument alone *even where there was no claim change made*. MPEP 1412.02.

In the instant case, a review of the prosecution history of applicant's original application SN # 08/573,561 shows that in the Amendment filed on January 8, 1997, applicant explicitly argued that "Claim 1 has been amended to include the coil spring *in tension between* the adjustment components (18, 20) to bias the components together to shorten the overall length of the first and second conduit sections (14, 16). The coil spring in tension is structure and none of the prior art suggest this combination." The spring in tension is why the claims were allowed in the parent application. To remove this limitation in the reissue claims is recapture. MPEP 1412.02 *supra*.

10. Applicant's arguments filed April 17, 2002 have been fully considered but they are not persuasive.

The examiner respectfully denies applicant's request to allow the method claims 30-36 because of the reasons, *inter alia*, listed below:

(a) applicant's method claims and apparatus claims are patentably distinct as explained on page 3 *et seq.* of the Office action on December 21, 1999. Moreover, applicant's method claims are not dependent from or otherwise include all of the limitations of an allowable apparatus claim, therefore, applicant's method claims may not be rejoined with the allowable apparatus claim. See 1184 O.G. 86;

(b) applicant's contention that applicant would endure further undue hardship and expense to file a divisional application is well taken, however, the undue hardship or expense are equally applied not only to the instant applicant but also to other applicants who have to file the divisional applications for claiming patentably distinct invention as required under 35 USC 121 and 37 CFR 1.141 and 1.142; and

(c) the apparatus claims are not allowable due to recapture rule, thus, the method claims are still withdrawn.

11. Applicant's arguments with respect to claims 4-29 and 37-40 have been considered but are moot in view of the new ground(s) of rejection.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 8:30 AM EST to 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

August 26, 2002



Vinh T. Luong
Primary Examiner